means comprise partially detached longitudinal strips of the conduit having a free end and a fixed end, the later being attached to the conduit.

51. (new) The implant of claim 43 where the laterally extending nidi-forming means is detachable from the implant.

In the Abstract:

Cancel the abstract and substitute the following:

An eyeball implant for replacement conduction of aqueous humor from the chambers of the eyeball to the subconjunctival tissue and ultimately to the venous system is comprised of an elongated fluid conducting conduit having distal and proximate ends, a sidewall and an interior passageway and at least one longitudinally extending opening in the sidewall that exposes the interior passageway and at least one nidi-forming structure carried by the conduit and extending laterally therefrom to implement the formation of at least one aqueous filtration bleb in the tissue of the eyeball. In one embodiment, the implant also contains at least one releasable ligature circumscribing the conduit. In another embodiment, the implant also contains an anchor appended to the conduit to prevent it from migrating from its placement site.

Remarks

Claims 1-42 are pending in the application. Claims 2-7, 10, 12, 13, and 15-42 have previously been withdrawn from consideration as belonging to a non-elected invention and/or species. Claims 1, 8, 9, 11, and 14 stand rejected. By this Amendment, claims 1-36 are cancelled and new claims 43-51 are submitted and their addition to the application is requested.

The Examiner stated that Applicant's application contains three inventions: group I pertains to a tube for implantation into an eye; group II pertains to a method for reducing intraocular pressure; and group III pertains to an implant with means for customizing its hydraulic conductance (Examiner's

Action at p. 2). Accordingly, the Examiner required that Applicant restrict the application to one of these inventions. Applicant confirms restriction to the invention contained in group I, which includes claims 1-36. However, because claims 1-36 are cancelled, Applicant contends that the Examiner's requirement for election and restriction is rendered moot by the presentation of new claims 43-51, which are directed to only one patentably distinct invention.

The Examiner also stated that the application contains claims directed to four patentably distinct species as embodied in (A) Figures 4, 6, 7, 10, 11; (B) Figures 5, 15, 16; (C) Figures 8, 9; and (D) Figures 12, 13, 14. The Examiner stated that Applicant is required to elect a single disclosed species for prosecution on the merits if no generic claim is allowed. Applicant contends that new claim 43 is an allowable generic claim to all four species. However, because Applicant is required to elect a single disclosed species should Examiner find no generic claim allowable, Applicant elects, with traverse, species A.

The Examiner concluded that Applicant's application contains four patentably distinct species. From the figures cited by the Examiner, species A appears to be directed to a tube with one lateral peeled back portion and a bifurcated anchor; species B appears to be directed to a tube with more than one lateral peeled back portion and a bifurcated anchor; species C appears to be directed to a tube with a quadricated anchor; and species D appears to be directed to a tube with scalloped nidus extending from the side of the opening of the tube. The Examiner concluded that Applicant must elect a species because the application contained no generic claims. However, the claims directed to species A are generic claims. As divided by the Examiner, species A includes a tube with one lateral peeled back portion and a bifurcated anchor. Thus, a tube with more than one lateral peeled back portion (species B) and/or with more than two divisions in the anchor (species C) would contain, by definition, the tube contained in species A. Stated simply, a tube with two lateral peeled back portions necessarily contains the one peeled back portion of species A and an anchor with four divisions necessarily contains the two

divisions depicted in species A.

In addition, the scalloped nidus of species D is an additional limitation that may be added to the tube of species A. The scalloped nidus is a form of nidi that is already contained in species A. This optional additional limitation by way of specificity is not a basis for a finding that species A is not actually generic. As stated by MPEP § 806.04(d), Definition of a Generic Claim: "In general, a generic claim should include no material element additional to those recited in the species claims. . . " (emphasis added). Thus, the generic claim cannot contain any limitation not found in the species claims, but the species claim can and should contain defining limitations in addition to the limitations recited in the generic claim. Therefore, the fact that species D contains defining limitations of the elements contained in the generic species A supports the conclusion that species A is, in fact, generic.

As stated above, Applicant asserts that the foregoing amendments place a generic claim in condition for allowance, thereby addressing the Examiner's concerns. Accordingly, Applicant submits claims 43-51.

The Examiner rejected claims 1, 8, 9, and 14 under 35 U.S.C. § 102(b) as being anticipated by Kousai et al (US 4,883,468). Examiner's Action at p. 5. The Examiner stated that Kousai discloses a tube for implantation into an eye that has a lateral peeled back portion that creates an open side walled portion. The Examiner also stated Kousai discloses the location of an anchor on the proximal end of the tube and that a cross section of the tube is in the shape of an arch.

Applicant respectfully disagrees.

Kousai discloses a medical tool introduction cannula. The introduction cannula described in Kousai is inserted into a blood vessel together with inner cannula of a syringe, which is inserted into the introduction cannula. Kousai at col. 5, lines 53-55; Fig. 8. The inner cannula is pulled out, leaving the introduction cannula in the blood vessel. Kousai at col. 5, lines 55-57. A catheter is then inserted into the introduction cannula, thereby introducing the

catheter into the blood vessel. Kousai at col. 5, lines 58-60. The introduction cannula is then removed from the catheter by cutting the introduction cannula along its weld line, which extends the entire length of the cannula. Kousai at col. 5, lines 61-66; Fig. 3.

In order to constitute a proper basis for a section 102(b) rejection, Kousai must contain each and every element of Applicant's invention. However, Kousai does not disclose nidi-forming member means. In contrast to Applicant's invention, nothing in Kousai remains in the body or vessel. Instead, Kousai's introduction cannula is a vehicle used for the insertion of a more permanent structure, like a catheter. Applicant's invention is an implant that remains in the body. As such, the implant or parts of the implant serve as nidi for the formation of capsules for aqueous filtration. Obviously, nothing in Kousai can serve as nidi-forming means given that the entire structure of Kousai is inserted momentarily only to facilitate insertion of something else into a vessel. Thus, because Kousai fails to contain nidi-forming means, Kousai is not a proper basis for a section 102(b) rejection. Furthermore, Kousai does not disclose an eyeball *implant* and does not disclose an elongated fluid-conducting conduit. The Kousai cannula does not conduct fluid and does not, until the weld strip is removed, contain at least one longitudinally extending opening in the sidewall.

Claims 43-51 now structurally define the implant and patentably distinguish over the prior art of record. Kousai is not a proper §102 or §103 reference for the submitted new claims 43-51 and their allowance is solicited.

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicant has reviewed the specification and believes that the specification fully supports the newly submitted claims 43-51 and further that the substituted abstract inserted by this Amendment fully addresses the Examiner's objection.

The foregoing amendments and arguments are believed to be a complete response to the Examiner's Action. An early action to pass the case to issue will be appreciated.

Respectfully submitted,

By _____
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